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EXAMINER

PASS, NATALIE

ART UNIT PAPER NUMBER

3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/780,266

Applicant(s)

SHERMAN, LAWRENCE M.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-49, 51-54, 59-61 and 64-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-49, 51-54, 59-61, 64-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 December 2006 has been entered.

2. This communication is in response to the Request for Continued Examination and amendment filed on 29 December 2006. Claims 27-31, 33-36, 40-41, 43-49, 54, 59-61 have been amended. Claims 1-26, 50, 55-58, 62-63 have been cancelled. Claims 64-72 have been newly added. Claims 27-49, 51-54, 59-61, 64-72 remain pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Newly amended claims 59-61 and newly added claims 64-69 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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(A) Claims 59-61, 64-69 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- "said secondary [or additional] insurance policy being independent in effect from and without affect to said primary [or previously issued] insurance policy and any benefits provided under said primary insurance policy," as disclosed in claim 59 at lines 8-10, claim 61 at lines 12-14, claim 64 at lines 7-9, claim 66 at lines 14-16, and claim 68 at lines 14-15;
- "independent of said primary insurance policy and any benefits of said primary [or previously issued] insurance policy," as disclosed in claim 59 at lines 33-34, claim 60 at lines 35-36, claim 61 at lines 24-25, claim 64 at lines 20-21, and claim 68 at lines 16-17;
- "determining whether said primary insurer is a select primary insurer," as disclosed in claims 64, 66, 68, at lines 13, 8-9 and 8-9, respectively
- "determining the time that has elapsed," as disclosed in claims 65, 67, 69, at lines 3, 3, 3, respectively.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

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In particular, the Examiner was unable to find any support for this newly added language within the specification as originally filed on 9 February 2001. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 9 February 2001.

6. The rejections of claims 62 and 63 under 35 U.S.C. 112, first paragraph is hereby withdrawn due to the amendment submitted 29 December 2006.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Newly amended claims 59-61 and newly added claims 64, 66, and 68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claims 59, 61, 64, 66, and 68 recite "said secondary [or additional] insurance policy being independent in effect from and without affect to said primary [or previously

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issued] insurance policy and any benefits provided under said primary insurance policy," at lines 8-10, 12-14, 7-9, 14-16, and 14-15, respectively;

(B) Claims 59, 60, 61, 64, and 68 recite "independent of said primary insurance policy and any benefits of said primary [or previously issued] insurance policy," at lines 33-34, 35-36, 24-25, 20-21, and 16-17, respectively.

It is unclear how the term "independent" limits the relationship between the primary insurance policy and the secondary or additional insurance policy, as Examiner is unable to locate the definition of the scope of that "independence" in Applicant's specification. For example, does Applicant intend "independent of" to mean "different from"? The primary and secondary policies, in this case, are obviously related in that the insured is the same person for both policies, and eligibility for the second policy depends (or "relies") on eligibility for the first. For the purpose of applying art, Examiner interprets the "independent" feature to mean "different from."

Other claims, which are not listed, may also contain language that is unclear. The applicant is encouraged to review the claim language to find other instances of lack of clarity in the claims.

9. The rejection of claims 27, 28, 29, 36 and 60 under 35 U.S.C. §112, second paragraph, is hereby withdrawn due to the amendment filed 29 December 2006.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 59-61, 27-31, 36, 44-45, 51-54, 64-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Underwood, et al., U.S. Patent Number 5, 873, 006, for substantially the same reasons given in the previous Office Action (paper number 05182006), and further in view of Ferling, et al. article, "New Plans, New Policies," April 1991, hereinafter known as Ferling. Further reasons appear hereinbelow.

(A) Claim 59 has been amended to include the recitation of

- "[...] if said secondary insurer can rely upon said underwriting approval of said primary insurer to provide said secondary insurance policy [...]" in lines 27-28.

As per newly amended claim 59, Underwood teaches a computer-implemented method for providing additional insurance for one or more persons as a secondary insurance policy provided by a secondary insurer based on an underwriting approval of said one or more persons a select primary insurer provides for a primary insurance policy, the computer-implemented method comprising:

providing a computer configured for receiving input data and for processing and converting said input data into output data defining said secondary insurance policy,

(Underwood; column 1, lines 36-39, column 2, lines 10-14);

receiving, as part of said input data, one or more underwriting "guidelines" (reads on "standards") said select primary insurer uses to provide said underwriting approval of said one

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or more “insured[s]” (reads on “persons”) for said primary insurance policy (Underwood; column 2, lines 20-33),

processing and converting said input data into said output data includes determining whether said one or more underwriting standards meets one or more criteria said secondary insurer applies to determine if said secondary insurer can rely upon said underwriting approval of said select primary insurer for said primary insurance policy to provide said secondary insurance policy (Underwood; column 2, lines 42-47, column 4, lines 46-56);

receiving, as part of said input data, information identifying said one or more persons and at least one secondary benefit amount of said secondary insurance policy (Underwood; column 2, lines 42-51);

generating, as part of said output data, an indication of acceptance of said one or more persons for said secondary insurance policy (Underwood; column 6, lines 11-14); and

using said output data to define said secondary insurance policy, said secondary insurance policy creating an obligation of said secondary insurer to pay said secondary benefit amount (Underwood; column 6, lines 11-14, 50-55).

Although Underwood teaches

“multiple excess insurance policies, each of the policies will typically be written by a different insurance company, and will be reinsured through other insurance companies” (reads on “processing and converting said input data into output data defining said secondary insurance policy”) (Underwood; column 1, lines 36-39), and generating, as part of said output data, an indication of acceptance of said one or more persons for said secondary insurance policy (Underwood; column 6, lines 11-14), Underwood fails to explicitly disclose

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said secondary insurance policy being independent in effect from and without affect to said primary insurance policy and any benefits of said primary insurance policy;

if said secondary insurer can rely upon said underwriting approval of said primary insurer to provide said secondary insurance policy, and

independent of said primary insurance policy and any benefits of said primary insurance policy.

However, the above features are well-known in the art, as evidenced by Ferling.

In particular, Ferling teaches a method further comprising

said secondary insurance policy being independent in effect from and without affect to said primary insurance policy and any benefits of said primary insurance policy (Ferling; page 2, paragraphs 1-10);

if said secondary insurer can rely upon said underwriting approval of said primary insurer to provide said secondary insurance policy (Ferling; page 2, paragraphs 1-10); Examiner interprets Ferling's teachings of "without evidence of insurability" (Ferling; page 2, paragraph 6) to teach a form of relying upon said underwriting approval of said primary insurer; and

independent of said primary insurance policy and any benefits of said primary insurance policy (Ferling; page 2, paragraphs 1-10); Examiner interprets Ferling's teachings of "a separate product" (Ferling; page 2, paragraph 7) to teach a form of independent of said primary insurance policy and any benefits of said primary insurance policy.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Underwood to include these limitations, as taught by Ferling, with the motivations of providing a product that allows insured customers to "increase the daily

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benefit maximum each year, without evidence of insurability, even if the insured is ... receiving benefits” (Ferling; page 2, paragraph 4).

(B) Newly amended claim 60 differs from amended method claim 59, in that it is a system rather than a method for providing additional insurance for one or more persons as a secondary insurance policy provided by a secondary insurer.

Amended system claim 60 repeats the subject matter of amended claim 59, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 59 have been shown to be fully disclosed by the combined teachings of Underwood and Ferling in the above rejection of claim 59, it is readily apparent that the system disclosed by Underwood and Ferling includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 59, and incorporated herein.

The motivations for combining the respective teachings of Underwood and Ferling are as given in the rejection of claim 59 above, and incorporated herein.

(C) Newly amended claim 61 differs from method claim 59, in that it is a method of providing additional insurance as a secondary insurance policy rather than a computer-implemented method for providing additional insurance for one or more persons as a secondary insurance policy.

As per the recitation of “computer-implemented” in the preamble of claim 59, as compared to not being implemented on a computer, this variation does not present a patentable

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distinction over the applied prior art of record and independent claim 61 is therefore rejected for the same reasons given above for claim 59.

The remainder of claim 61 recites substantially the same limitations as claim 59, and is therefore rejected for the same reasons provided for that claim and incorporated herein.

The motivations for combining the respective teachings of Underwood and Ferling are as given in the rejection of claim 59 above, and incorporated herein.

(D) As per newly amended claims 27-30, 36, 44-45, Underwood and Ferling teach a method as analyzed and discussed in claim 59 above,

further comprising receiving, as part of said input data, information relating to one or more terms of said primary insurance policy and further determining eligibility of said one or more “insured[s]” (reads on “persons”) for said secondary insurance policy based on said one or more terms (Underwood; Abstract, column 2, lines 48-52);

wherein the said one or more terms includes a benefit amount of said primary insurance policy (Underwood; column 2, lines 48-52);

wherein said one or more terms includes a date of issuance of said primary insurance policy (Underwood; Figure 7, column 3, lines 30-35);

wherein said one or more terms includes an expiration date of said primary insurance policy (Underwood; Figure 7, column 3, lines 30-35);

further comprising receiving, as part of said input data, information related to one or more “guidelines” (reads on “standards”) used by said primary insurer to determine eligibility of said one or more “insured[s]” (reads on “persons”) for said primary insurance policy

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(Underwood; column 2, lines 20-33);

further comprising receiving, as part of said input data, information from at least one of said one or more persons in response to one or more queries and further determining eligibility of said one or more “insured[s]” (reads on “persons”) for said secondary insurance policy based on said response information (Underwood; column 2, lines 42-52, column 4, lines 46-56); and

further comprising receiving, as part of said input data, “documentation” (reads on “outcome”) of one or more risk reduction procedures and further determining eligibility of said one or more persons for said secondary insurance policy based on said risk reduction procedure outcome (Underwood; Figure 8, Figure 9, column 2, lines 42-52, column 5, lines 1-7, column 6, lines 11-14).

(E) As per newly amended claim 31, Underwood and Ferling teach a method as analyzed and discussed in claims 59 and 27 above.

Underwood and Ferling fail to explicitly disclose

wherein said one or more terms includes one or more conditions that would, if met, void said primary insurance policy.

However, the above features are well known in the art, and Underwood clearly teaches “[p]rimary insurance carrier ...records are also stored in the database. Each of the primary insurance carrier ... records includes a field for storing a rating code ... associated with a primary insurance carrier... for documenting and storing ... code[s] and related underwriting criteria associated with the policy” and “it is important for all relevant information pertaining to the ... policy to be properly documented and permanently stored at the time that the policy is initially issued” and “[a]t the time of binding, the insurance business producer is required to enter into the

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system information relating to the reinsurance of the policy which has been bound” (Underwood; Abstract,; column 1, lines 45-49, column 6, lines 38-41).

It is respectfully submitted that since Underwood is directed to “managing insurance underwriting and related processes associated with the excess casualty [reads on “secondary”] insurance business” where “the purpose of an excess [reads on “secondary”] insurance policy is to cover an insured in the event that the insured incurs liability that is in excess of the coverage limits of its primary insurance policy” (Underwood; column 1, lines 10-12, 18-21), and since Underwood’s teaches the importance of “documenting an insured’s limits, attachment points, contract duration and for retrieving public bureau ... information regarding underlying carrier(s),” (Underwood; column 3, lines 30-34), Underwood’s teachings as recited in the above passages, broadly reads on the claimed limitations.

It is the position of the Examiner that one having ordinary skill in the art at the time of the invention would have found it obvious to include these limitations within the method disclosed by Underwood, with the motivations of “providing a system for quoting excess [reads on “secondary”] insurance which requires the quoted premium to accurately reflect the risks associated with a policy, and which permits the auditing of the risk characteristics, rating and pricing methodology associated with a quote before it is issued” and ensuring that “all relevant information pertaining to the ... policy ... [is] ... properly documented and permanently stored” (Underwood; column 1, line 48 to column 2, line 3).

(F) As per claims 51-54, Underwood and Ferling teach a system as analyzed and discussed in claim 60 above

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wherein said one output device operatively connected to the broker computer is configured for transmitting to said customer computer via the network information regarding said secondary life insurance policy (Underwood; Figure 2, column 4, lines 4-9);

wherein the broker computer is communicatively connected to at least one primary insurer computer via the network (Underwood; Figure 2, column 4, lines 4-9);

wherein the broker computer and the primary insurer are communicatively connected to one or more databases via the network, the one or more databases including information related to at least one of; the one or more persons, the primary life insurance policy and the primary insurer (Underwood; Figure 2, column 4, lines 4-9); and

wherein the broker computer is communicatively connected to one or more databases via the network, the one or more databases including information related to at least one of the one or more persons, the primary life insurance policy and the primary insurer (Underwood; Figure 2, column 4, lines 4-9).

(G) As per newly added claim 64, Underwood and Ferling teach a computer-implemented method for providing additional insurance for one or more persons as a secondary insurance policy provided by a secondary insurer based on an underwriting approval of said one or more persons given by a primary insurer for a primary insurance policy, the computer-implemented method comprising:

providing a computer configured for receiving input data and for processing and converting said input data into output data for defining, in part, said secondary insurance policy (Underwood; column 1, lines 36-39, column 2, lines 10-14), said secondary insurance policy being independent in effect from and without affect to said primary insurance policy and any

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benefits provided under said primary insurance policy (Ferling; page 2, paragraphs 1-10);

receiving, as part of said input data, information identifying said primary insurer, said primary insurance policy, and said one or more persons (Underwood; column 2, lines 42-51);

processing and converting said input data into said output data includes determining whether said primary insurer is a select primary insurer, said select primary insurer being an insurer said secondary insurer believes uses an acceptable underwriting evaluation, and determining whether said select primary insurer provided underwriting approval of said one or more persons for said primary insurance policy (Underwood; column 2, lines 20-33, 42-51, column 4, lines 46-56); and

if said primary insurer provided underwriting approval of said one or more persons for said primary insurance policy, generating, as part of said output data, said secondary insurance policy, said secondary insurance policy creating an obligation of said secondary insurer to pay at least one benefit amount independent of said primary insurance policy and any benefits of said primary insurance policy (Underwood; column 6, lines 11-14, 50-55), (Ferling; page 2, paragraphs 1-10).

The motivations for combining the respective teachings of Underwood and Ferling are as given in the rejections of claim 59 above, and incorporated herein.

(H) As per newly added claim 66, Underwood and Ferling teach a method of providing additional insurance for one or more persons as an additional or replacement insurance policy, the method comprising:

identifying a prior insurer that provided a previously issued insurance policy for said one

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or more persons (Underwood; column 2, lines 42-51);

determining whether said prior insurer provided an underwriting approval of said one or more persons for said previously issued insurance policy (Underwood; column 2, lines 20-33, 42-47, column 4, lines 46-56);

if said prior insurer provided said underwriting approval of said one or more persons for said previously issued insurance policy, determining whether said prior insurer is an “acceptable” (reads on “a select”) prior insurer, said select prior insurer being designated by an additional insurer providing said additional or replacement insurance policy as using acceptable underwriting standards (Underwood; column 2, lines 14-52); Examiner interprets Underwood’s teachings of “means are provided for retrieving a primary insurance carrier rating record associated with the insured from the database and for comparing the rating code stored in the primary insurance carrier rating record to an acceptable predetermined rating level” (Underwood, column 2, lines 29-35) to teach a form of a select prior insurer;

if said prior insurer is a select prior insurer (Underwood; column 2, lines 14-52), providing without underwriting said additional or replacement insurance policy to provide additional insurance, said additional or replacement insurance policy being independent in effect from and without affect to said previously issued insurance policy and providing at least one benefit amount for said one or more persons independent of said previously issued insurance policy and any benefits of said previously issued insurance policy (Ferling; page 2, paragraphs 1-10); Examiner interprets Ferling’s teachings of “without evidence of insurability” (Ferling; page 2, paragraph 6) to teach a form of relying upon said underwriting approval of said primary insurer, and Examiner interprets Ferling’s teachings of “a separate product” (Ferling; page 2,

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paragraph 7) to teach a form of independent of said previously issued insurance policy and any benefits of said previously issued insurance policy.

The motivations for combining the respective teachings of Underwood and Ferling are as given in the rejections of claim 59 above, and incorporated herein.

(I) As per newly added claim 68, Underwood and Ferling teach a method of providing additional insurance for one or more persons for a specified risk, the method comprising:

identifying a prior insurer that provided a previously issued insurance policy for said one or more persons for said specified risk (Underwood; column 2, lines 42-51);

determining whether said prior insurer provided an underwriting approval of said one or more persons for said previously issued insurance policy (Underwood; column 2, lines 20-33, 42-51, column 4, lines 46-56);

if said prior insurer provided said underwriting approval of said one or more persons for said previously issued insurance policy, determining whether said prior insurer is an “acceptable” (reads on “a select”) prior insurer, said select prior insurer designated by an additional insurer providing said additional insurance policy as using acceptable underwriting standards (Underwood; column 2, lines 14-52); Examiner interprets Underwood’s teachings of “means are provided for retrieving a primary insurance carrier rating record associated with the insured from the database and for comparing the rating code stored in the primary insurance carrier rating record to an acceptable predetermined rating level” (Underwood, column 2, lines 29-35) to teach a form of a select prior insurer; and

if said prior insurer is an “acceptable” (reads on “a select”) prior insurer (Underwood; column 2, lines 14-52), providing said additional insurance policy to provide said one or more persons with additional insurance to cover said specified risk, said additional insurance policy being independent in effect from and without affect to said previously issued insurance policy and providing at least one benefit amount for said one or more persons independent of said previously issued insurance policy and any benefits of said previously issued insurance policy (Ferling; page 2, paragraphs 1-10); Examiner interprets Ferling’s teachings of “a separate product” (Ferling; page 2, paragraph 7) to teach a form of independent of said previously issued insurance policy and any benefits of said previously issued insurance policy.

The motivations for combining the respective teachings of Underwood and Ferling are as given in the rejections of claim 59 above, and incorporated herein.

(J) As per newly added claims 65, 67, 69, Underwood and Ferling teach a method as analyzed and discussed in claim 64 above

wherein determining whether said primary or prior insurer provided underwriting approval of said one or more persons for said primary or previously issued insurance policy includes determining the time that has elapsed between the date said primary or prior insurer provided said underwriting approval and the time said one or more persons applied for said secondary or additional or replacement insurance policy (Underwood; Figure 7, Figure 12, column 4, lines 12-17, 31-33, column 6, lines 40-43); Examiner interprets Underwood’s teachings of “... [...] ... the user enters into the system information pertaining the insured party for whom an excess casualty insurance quotation is to be prepared. Such information includes,

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for example, ... [...] ... the date the request for the quotation was received ... [...] ...”

(Underwood; column 4, lines 12-17) and “[t]he documentation entered by the user ... [...] ... is stored electronically by the system as part of a computer file ... [...] ... and may be used at the home office of the insurance carrier for approving a quotation” (Underwood; column 5, lines 1-5) together with Underwood’s dates listed in Figure 7 and Figure 12 to teach this limitation.

(K) As per newly added claims 70-72, Underwood and Ferling teach a method as analyzed and discussed in claims 64, 66, and 68 above

wherein determining whether said prior insurer provided underwriting approval of said one or more persons for said previously issued insurance policy includes determining whether said prior insurer provided said underwriting approval within a specified period of time (Underwood; Figure 7, Figure 12, column 4, lines 12-17, 31-33, column 6, lines 40-43); Examiner interprets Underwood’s teachings of “... [...] ... the user enters into the system information pertaining the insured party for whom an excess casualty insurance quotation is to be prepared. Such information includes, for example, ... [...] ... the date the request for the quotation was received ... [...] ...” (Underwood; column 4, lines 12-17) and “[t]he documentation entered by the user ... [...] ... is stored electronically by the system as part of a computer file ... [...] ... and may be used at the home office of the insurance carrier for approving a quotation” (Underwood; column 5, lines 1-5) together with Underwood’s dates listed in Figure 7 and Figure 12 to teach this limitation.

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12. Claims 32-35, 37-43, 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Underwood, et al., U.S. Patent Number 5, 873, 066 and Ferling, et al. article, "New Plans, New Policies," April 1991, hereinafter known as Ferling, as applied to claims 59 and 36 above, and further in view of Ryan, et al., U.S. Patent Number 5, 673, 402 for substantially the same reasons given in the previous Office Action (paper number 05182006). Further reasons appear hereinbelow.

(A) As per claims 32-35, Underwood and Ferling teach a method as analyzed and discussed in claims 59 and 27 above.

Underwood and Ferling fail to explicitly disclose a method wherein said one or more terms includes one or more statements received from at least one of said one or more persons in connection with the health of one of said one or more persons;

wherein said one or more terms of the primary insurance policy includes an age of at least one of said one or more persons;

wherein said one or more terms of said primary insurance policy includes the total number of said one or more persons; and

wherein said one or more terms of said primary insurance policy includes one or more conditions precedent to payment of said benefit amount.

However, the above features are well-known in the art, as evidenced by Ryan.

In particular, Ryan teaches a method

wherein said one or more terms includes one or more statements received from at least

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one of said one or more persons in connection with the health of one of said one or more persons (Ryan; column 19, lines 14-25);

wherein said one or more terms of the primary insurance policy includes an age of at least one of said one or more persons (Ryan; column 19, lines 14-25);

wherein said one or more terms of said primary insurance policy includes the total number of said one or more persons (Ryan; column 31, lines 31-36, column 46, lines 25-29);

wherein said one or more terms of said primary insurance policy includes one or more conditions precedent to payment of said benefit amount (Ryan. Column 1, lines 19-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Underwood and Ferling to include these recited limitations, as taught by Ryan, with the motivations of providing a computerized insurance system capable of identifying potentially higher risk individuals and providing specialized insurance values for those individuals (Ryan; column 6, lines 11-14).

The motivations for combining the respective teachings of Underwood and Ferling are as given in the rejection of claim 59 above, and incorporated herein.

(B) As per claims 37-43, Underwood and Ferling teach a method as analyzed and discussed in claims 59 and 36 above.

Underwood and Ferling fail to explicitly disclose

wherein said one or more standards includes one or more statements received from at least one of said one or more persons in connection with said person's health;

wherein said one or more standards includes an age of at least one of said one or more

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persons; and

wherein said one or more standards includes a profession at least one of said one or more persons;

wherein said one or more standards includes a benefit amount of said primary insurance policy;

wherein said one or more standards includes a term during which said primary insurance policy is effective;

wherein said one or more standards includes one or more responses received from at least one of said one or more persons in response to one or more antiselection questions; and

wherein said secondary benefit amount is less than a primary benefit amount provided under said primary insurance policy.

However, the above features are well-known in the art, as evidenced by Ryan.

In particular, Ryan teaches

wherein said one or more standards includes one or more statements received from at least one of said one or more persons in connection with said person's health (Ryan; column 19, lines 14-24, column 33, line 61 to column 34, line 12);

wherein said one or more standards includes an age of at least one of said one or more persons (Ryan; column 7, line 51 to column 8, line 1, (Ryan; column 19, lines 14-24, column 33, line 61 to column 34, line 12); and

wherein said one or more standards includes "employment" data (reads on "a profession at least one of said one or more persons") (Ryan; column 33, line 61 to column 34, line 12, column 39, lines 6-9);

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wherein said one or more standards includes a benefit amount of said primary insurance policy (Ryan; column 19, lines 14-24);

wherein said one or more standards includes a term during which said primary insurance policy is effective (Ryan; column 22, lines 23-26);

wherein said one or more standards includes one or more responses received from at least one of said one or more persons in response to one or more antiselection questions (Ryan; column 19, lines 34-35); and

wherein said secondary benefit amount is less than a primary benefit amount provided under said primary insurance policy (Ryan; column 11, lines 9-26, 41-54).

The motivations for combining the respective teachings of Underwood, Ferling, and Ryan are as given in the rejections of claims 32 and 59 above, and incorporated herein.

(C) As per claims 46-47, Underwood, Ferling, and Ryan teach a method as analyzed and discussed in claims 59 and 45 above

wherein one or more risk reduction procedures includes establishing a period of time during which an offer for said secondary insurance policy is effective (Ryan; column 19, lines 10-27); and

wherein one or more risk reduction procedures includes establishing a period of time within which a payment of a premium said the secondary insurance policy is “scheduled” (reads on “required”) (Ryan; column 9, line 64 to column 10, line 4).

The motivations for combining the respective teachings of Underwood, Ferling, and Ryan are as given in the rejections of claims 32 and 59 above, and incorporated herein.

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13. Claims 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Underwood, et al., U.S. Patent Number 5, 873, 066 and Ferling, et al. article, "New Plans, New Policies," April 1991, hereinafter known as Ferling, as applied to claim 59 above, and further in view Pescitelli, et al., U.S. Patent Number 5, 845, 256 for substantially the same reasons given in the previous Office Action (paper number 05182006). Further reasons appear hereinbelow.

(A) As per claims 48-49, Underwood and Ferling teach a method as analyzed and discussed in claim 59 above.

Underwood and Ferling fail to explicitly disclose a method further comprising receiving, as part of said input data, at least one beneficiary of said secondary life insurance policy; and wherein said at least one beneficiary of said secondary life insurance policy includes at least one beneficiary of said primary life insurance policy.

However, the above features are well-known in the art, as evidenced by Pescitelli.

In particular, Pescitelli teaches further comprising receiving, as part of said input data, at least one beneficiary of said secondary life insurance policy (Pescitelli; column 11, lines 20-29, column 13, lines 7-14); and wherein said at least one beneficiary of said secondary life insurance policy includes at least one beneficiary of said primary life insurance policy (Pescitelli; column 11, lines 20-29, column 13, lines 7-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Underwood and Ferling to include establishing beneficiaries

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of the life insurance policies, as taught by Pescitelli, with the motivations of providing an improved system, and method, for vending insurance contracts (Pescitelli; column 2, lines 49-52).

The motivations for combining the respective teachings of Underwood and Ferling are as given in the rejections of claim 59 above, and incorporated herein.

Response to Arguments

14. Applicant's arguments filed 29 December 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 29 December 2006.

(A) Applicant's arguments on page 15 of the response 29 December 2006 with respect to rejections under 35 USC § 112 have been considered and, together with amendments to the claims, have resulted in withdrawal of the previously applied rejections.

(B) Applicant's arguments on pages 16-25 of the response filed 29 December 2006 with respect to claims 27-49, 51-54, 59-61, 64-72 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Any response to this action should be mailed to:

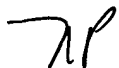
**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

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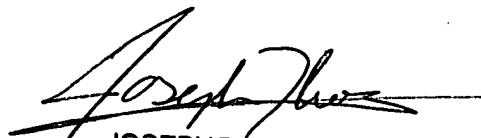
For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. After Final communications should be labeled "Box AF."

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.
17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.
18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

February 1, 2007



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER